



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/919,412

07/30/2001

Bin Lu

ENR-015

4205

7590

01/10/2006

WAGNER, MURABITO & HAO LLP
THIRD FLOOR
TWO NORTH MARKET STREET
SAN JOSE, CA 95113

EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,412

Applicant(s)

LU ET AL.

Examiner

Prieto B.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This communication is in response to RCE/Amendment filed 11/28/05, claims 1-43 have been examined.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/28/05 has been entered.

3. Regarding newly added or amended claims, Applicant has indicated 01/04/05, that a written description for added limitation, i.e. further limiting the location message to include "a preview of the media file" is not found in the specification of instant invention, in response to examiner's inquiry to show/point out support to the above-mentioned amendment (see MPEP 2163 B II, "Applicant should specifically point out the support for any amendments made to the disclosure." See MPEP 2163 B II).

The original claims as filed form part of the original disclosure. See *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973). As such, written description for the above-mentioned amendment may be found (at least) on claims 5 and 20, as filed on 7/30/01.

4. Claim interpretation, the claimed term "preview of the media file", has been applied the broadest reasonable interpretation (MPEP §2106/2111). In this case, in view of the lacking written description of said claimed term, this term will broadly mean, a view or an advance showing or to view in advance, sample or survey of a file.

Claim Rejection under 35 U.S.C. 103

5. Quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action may be found in previous office action.

6. Claims 1-6, 8-9, 13-21, 23-24, 28-36, 38, 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma (US 5,771,355) in view of Hoffert et. al. (US 5,903,892) (Hoffert hereafter) in further view of Rudy et. al. (US 6,360,252).

Regarding claim 1, Kuzma teaches a system (Figs. 1-3 and col 1/lines 26-56) and method (col 14/lines 24-43) configured to communicate media files, comprising:

a sender client configured to provide a message comprising: a recipient address and a handle to a media file (col 1/lines 13-22, col 2/lines 24-58), the handle to the media comprising reference to the media file (col 1/lines 36-67), and a pointer location to the media file (col 5/lines 10-54);

a server configured to receive and provide said message from the sender client to a receiver client that corresponds with said recipient address, said receiver client configured to receive said message from said server (col 3/lines 26-62);

wherein said receiver client is configured to access said media file from the sender client and a peer receiver client source of the media file (col 44/lines 44-47, col 5/lines 10-54 and col 6/lines 8-15), however Kuzma teaches a message comprising a handle to a media file, he does not teach where the media file includes copyright information.

Hoffert teachings related to the field of digital media such as audio/video clips (abstract, background) including the delivery via an email server (col 28/lines 11-16), teaches wherein to facilitate the delivery/retrieval of media files by indexing streaming media files with information describing the media files content, including a handle to the media file, e.g. URL and content attributes such as title, author, copyright information (col 6/lines 53-col 7/line 19).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma for retrieving media files using a handle to the media file, the teachings of Hoffert for enabling the retrieval of media files by attributes other than their type, would be readily apparent. One would be motivated to enhance files transmittable over the Internet including email, with file indexing attributes more descriptive of the content, such as the media file location, e.g. socket, header data, title, author, copyright, additional information such as resolution, duration, resolution, frame rate, etc. this would enable the receiver client ascertain the resources and the time required for selectively downloading desired media file, as explicitly suggested by the applied references.

However, the above-mentioned prior art does not teach sending a message further comprising a preview of a file.

Rudy teachings regarding digital media and the field of electronic email, teaches sending in a message a user understandable description of a file comprising the name of the file, and a small thumbnail of the image file (i.e. a view in advance or preview) (col 7/lines 49-58), wherein said file may include a media file (col 7/lines 14-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made given the suggestions of handling media files using email the teachings of Rudy would be readily

apparent. One of ordinary skill in the art would be motivated to include a preview of the media file in the form of a thumbnail, which provides a preview image of and an index to the corresponding full size of the media file. One would be motivated to apply Rudy's teachings because they can be used where there is a low bandwidth connection between the server and a user's client machine, where there is a high latency connection such as through a satellite link or a modem or Wireless Application Protocol (WAP) phone that requires time to establish connection, or where there is an unreliable or intermittent connection. In addition, the techniques are advantageous because they can be used where the client machine is not adequate to render most attachments due to storage limitations or due to inadequate output capabilities, such as a small display or a display with inadequate resolution.

Regarding claims 2-3, wherein the sender and receiver clients are a personal computer (120 of Figs. 1-2, col 3/lines 7-18).

Regarding claim 4, wherein the server is an application service provider accessed via an Internet (301)(col 3/lines 19-46, col 3/line 63-col 4/line 10).

Regarding claim 5, wherein said message comprises a text of data information (col 1/lines 23-25).

Regarding claim 6, address are network email address (col 1/lines 14-22)

7. Claims 7, 22, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma in view of Hoffert in further view of Hsu et. al. (US 6,295,058) (Hsu hereafter).

Regarding claim 7, Hsu teachings pertaining the invention's field of endeavor, discusses as prior art the transmission of electronic mail containing audio and/or visual files obtained from various sources, e.g. a video cassette recorder or camcorder are converted in a suitable format, e.g. MPEG and stored locally on a storage device, and transmitting stored files as an email to a mail server (col 2/lines 3-15).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma that the personal computers may be any suitable computer system which additionally may include a special purpose video processor, a video camera, and graphic viewer programs for rendering graphic files associated with email messages. One ordinary skilled in the art would be motivate create multimedia emails with a simple for of

electronic communication to enable accessible to the general public and using an open architecture providing a service independent of the email service provider, as taught by Hsu.

Regarding claims 8-9, the sender and receiver client is further configured to use an HTTP protocol to provide and receive the location message (Kuzma: col 3/lines 63-col 4/line 31, 44-50).

8. Claims 10-12, 25-27 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma in view of Hoffert in further view of Thurlow et. al. (US 6,457,879) (Thurlow hereafter).

Regarding claims 10-12, 25-27 and 39-41, however Kuzma does not explicitly teach a connection determination step.

Thurlow teaching pertaining to the invention's field of endeavor, teach determining the connection status between a client and server (col 15/lines 47-57, col 16/lines 54-67), and processing messages according to determined connection status (abstract).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma for enabling clients to have server functions to enable any client access each other in a peer fashion to include Thurlow's teachings for processing messages, e.g. sending and receiving between clients via servers. The teachings of Thurlow when applied to Kuzma will enable the clients or server to perform connection status determinations and process messages according to determined status. One would be motivated to provide users poll email server or client, e.g. recipients while online for incoming messages or reception availability, respectively, or offer user the option to work online or offline, discussed by Thurlow.

Regarding claims 13-15, connections between sender, mail server and recipient are Internet protocol based supported (Kuzma: col 12/lines 33-49). The system of claim 1, further comprising:

Regarding claim 16, this claim is substantially the same a claim 1 as discussed, wherein "configured" has been changed for "coupled", same rationale of rejection is applicable.

Regarding claims 17-22, these claims are substantially the same as claims 2-7, discussed above same rationale of rejection is applicable.

Regarding claim 23, the protocol used by the receiver client to provide the location message is HTTP (Kuzma: col 12/lines 33-49).

Regarding claim 24-30, these claims are substantially the same as claims 9-15, same rationale of rejection is applicable.

Regarding claim 31, this claim comprises in substance the same subject matter discussed on claim 1, same rationale of rejection is applicable.

Regarding claims 32-43, these claims are substantially the same as claims 2-15, same rationale of rejection is applicable.

9. Claims 1, 16 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuzma in view of Hoffert in further view of Visual Preview for Link Traversal on the WWW, Kopetzky, T. et. al. (Kopetzky hereafter).

Regarding claim 1, Kuzma teaches a system (Figs. 1-3 and col 1/lines 26-56) and method (col 14/lines 24-43) configured to communicate media files, comprising:

- a sender client configured to provide a message comprising: a recipient address and a handle to a media file (col 1/lines 13-22, col 2/lines 24-58), the handle to the media comprising reference to the media file (col 1/lines 36-67), and a pointer location to the media file (col 5/lines 10-54);

- a server configured to receive and provide said message from the sender client to a receiver client that corresponds with said recipient address, said receiver client configured to receive said message from said server (col 3/lines 26-62);

- wherein said receiver client is configured to access said media file from the sender client and a peer receiver client source of the media file (col 44/lines 44-47, col 5/lines 10-54 and col 6/lines 8-15), however Kuzma teaches a message comprising a handle to a media file, he does not teach where the media file includes copyright information.

Hoffert teachings related to the field of digital media such as audio/video clips (abstract, background) including the delivery via an email server (col 28/lines 11-16), teaches wherein to facilitate the delivery/retrieval of media files by indexing streaming media files with information describing the

media files content, including a handle to the media file, e.g. URL and content attributes such as title, author, copyright information (col 6/lines 53-col 7/line 19).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Kuzma for retrieving media files using a handle to the media file, the teachings of Hoffert for enabling the retrieval of media files by attributes other than their type, would be readily apparent. One would be motivated to enhance files transmittable over the Internet including email, with file indexing attributes more descriptive of the content, such as the media file location, e.g. socket, header data, title, author, copyright, additional information such as resolution, duration, resolution, frame rate, etc. this would enable the receiver client ascertain the resources and the time required for selectively downloading desired media file, as explicitly suggested by the applied references.

However, the above-mentioned prior art does not teach utilizing a preview of a file for describing a media file.

Kopetzky teaches adding the handle to a media file comprising a pointer to the location of a media file, a preview of the media file, denoted link preview. The link further comprises a preview image (Fig. 1, 2a-b and 3a) of the media file (p. 1-3). The enhanced links can be used for preview purposes (p. 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made given the suggestion of Kuzma using a handle to a media file comprising a reference to the media file and a pointer location to the media file, the teachings of Kopetzky for further enhancing said handle to a media file comprising a reference to the media file and a pointer to the location of the media file would have been readily apparent. One would be motivated to overcome the limitation of existing prior art in (discussed by Kopetzky) providing information regarding a media file other than textual hints provided to help the user to decide if a link is worthwhile to follow, because these are not supported by the standards browser. One would be motivated to apply the Kopetzky teachings to Kuzma's handle to a media file comprising a reference to the media file and a pointer location to the media file, because the technique can be used to implement a local overview fro web browsing and at the same time works with standard browsers without authoring effort and provides the user with a view of e.g. the page and content associated with the link, as noted by Kopetzky.

Regarding claim 16, this claim is substantially the same a claim 1 as discussed, wherein "configured" has been changed for "coupled", same rationale of rejection is applicable.

Regarding claim 31, this claim comprises in substance the same subject matter discussed on claim 1, same rationale of rejection is applicable.

Response to Arguments

10. Regarding claims 1, 16, and 31 are rejected as being unpatentable over Kuzma in view of Hoffert, it is argued the applied prior art does not teach added limitation. Specifically, wherein the message includes a preview of the media file.

Applicant's arguments with respect to claim added limitation have been considered but are moot in view of the new ground(s) of rejection.

11. Regarding claims 2-3, 17-18, and 32-33, it is argued that the applied prior art does not teach claim limitation a recited. Specifically, the sender client is selected from a personal video recorder and a video camcorder.

In response to the above-mentioned argument, applicant's attention is directed to MPEP §2173.05(h) Alternative Limitations I. MARKUSH GROUPS Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). Claims 2-3, 17-18, and 32-33 have been treated accordingly.

12. Regarding claims 4, 5, 8, 13 and 5, it is argued that the applied prior art does not teach claim limitation a recited. Specifically, the sender client is selected from a personal video recorder and a video camcorder.

In response to the above-mentioned argument, same rationale of rejection and response to argument applied to claims 2-3, 17-18, and 32-33 is applicable.

13. Applicant's argument filed 11/28/05 have been fully considered but not rendered persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Hand carried or delivered to:
Customer Service Window located at the Randolph Bldg.
401 Dulany St.
Alexandria, VA 22314

Faxed to the Central Fax Office:
(571) 273-8300 (New Central Fax No.)

Or Telephone:

(571) 272-2100 for TC 2100 Customer Service Office.

B. Prieto
Primary Examiner
TC 2100
January 6, 2006


BEATRIZ PRIETO
PRIMARY EXAMINER